

Remarks

Based on the following remarks, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections set forth in the Action.

A. Status of the Claims

Claims 1-15 and 32-82 are currently pending in the application for examination. Claim 1 has been amended. Support for the amendment of claim 1 may be found throughout the specification, for example, in Example 1, paragraph [0119], of the published application. Claim 15 has been amended to correct the statement of multiple dependency. Claim 71 has been withdrawn. Thus, no new matter has been added.

B. Claim Objections

Claim 15 stands objected to because of an unclear statement of this claim's multiple dependency. Accordingly, claim 15 has been amended as suggested by the Action to remove this ambiguity, thus, obviating this ground for objection.

Claim 71 has been objected to as being drawn to a non-elected invention. Applicants have withdrawn claim 71, thus obviating this ground for rejection.

C. Rejection of Claims Under 35 U.S.C. § 101 and 35 U.S.C. § 112, first paragraph - enablement

Claims 1, 3, 5, 6, 8, 9, 55, 59, 62, 64, 65, 71, 76, and 78 stand rejected under 35 U.S.C. § 101 for allegedly lacking either a specific, substantial, and credible asserted utility, or a well established utility. In making this rejection, the Action states that "the claimed composition fairly encompasses the template, which was elected by applicant to be mRNA." The Action takes the position that a utility rejection is justified because mRNAs can include expressed sequence tags for which no

known utility exists. *See* Action at page 3. Applicants respectfully traverse this ground for rejection.

In light of the rejection of claims 1, 3, 5, 6, 8, 9, 55, 59, 62, 64, 65, 71, 76, and 78 for alleged lack of utility, the Action has also rejected these claims under 35 U.S.C. § 112, first paragraph, for alleged lack of enablement. *See* Action at page 3-4, bridging paragraph. Applicants respectfully traverse this ground of rejection as well.

Applicants believe that the arguments presented in the previous Office Action response are sufficient to overcome this rejection. In an effort to advance prosecution, Applicants provide the following additional remarks to address these rejections.

The presently claimed invention is directed to a composition for the labeling of nucleic acid molecules using two or more modified deoxyribonucleotide triphosphates. As pointed out in the specification, the process of converting a population of mRNA molecules into a labeled first-strand cDNA population, for a wide variety of applications, such as screening a nucleic acid microarray, is well-known and widely used. *See, e.g.*, paragraph [0013] of the published application, US 2004/0265870. Applicants respectfully submit that by claiming a composition that has application in a widely used method, the claimed invention, at a minimum has a well established utility. The fact that a starting mRNA population derived, for example, from a cell line, contains within it short bits of mRNA sequences which have been arbitrarily characterized as ESTs does not detract from the well established utility of the claimed invention as a whole for the labeling of nucleic acids. Indeed, the labeling of nucleic acids is an important procedure in molecular biology, and thus, has a well established utility that extends to the claimed invention.

Applicants respectfully submit that, at a minimum, a skilled artisan would easily recognize the presently claimed invention to have a well established utility, thus satisfying the utility requirement. Accordingly, Applicants respectfully request that this ground for rejection be

withdrawn. Furthermore, in light of the satisfaction of the utility requirement, Applicants further request that the rejection for lack of enablement also be withdrawn.

D. Rejection of Claims Under 35 U.S.C. § 103(a)

Claims 1, 3, 5, 6, 8, 9, 55, 59, 62, 64, 65, 71, 76, and 78 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 6,709,815 (“Dong”) in view of U.S. Patent No. 6,906,244 (“Fischer”). Applicants respectfully traverse this ground for rejection.

The Action cites Dong for the disclosure of the use of modified nucleotides, such as dUTP, 7-deaza-dATP, or 7-deaza-dGTP, in reaction mixtures for PCR or RT-PCR. *See* Action at pages 5-6. The Action also cites Fischer for the disclosure of aminoallyl-dUTP in an assay utilizing reverse transcriptase and mRNA. *See* Action at page 6.

Applicants have amended claim 1 to recite, “[a] composition comprising 2 or more different, modified, monomeric deoxyribonucleotide triphosphates . . . wherein said modified deoxyribonucleotide triphosphates are present in substantially equimolar amounts.” Applicants respectfully submit that Dong does not teach or suggest a composition comprising modified deoxyribonucleotide triphosphates present in equimolar amounts, as recited in amended claim 1. Furthermore, this claim element is also not present in the combination of Dong with Fischer. Accordingly, the cited references, alone and in combination, fail to teach each and every element of the claimed invention, as required to establish a *prima facie* case of obviousness, and Applicants respectfully request withdrawal of this rejection.

D. Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. Applicants believe that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance.

Prompt and favorable consideration of this Amendment and Reply is respectfully requested.

Respectfully submitted,

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